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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/435,736 | 11/08/1999 | ARTHUR REISMAN | 4366-41 | 5609 |
| 7590 | 03/09/2004 | | EXAMINER | |
| Douglas W. Swartz Sheridan Ross P.C. 1560 Broadway Road Suite 1200 Denver,, CO 80202 | | | NGUYEN, MINH DIEU T | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2137 | |
| | | | DATE MAILED: 03/09/2004 | |
| | | | | 8 |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | |
|--|------------------------------|------------------|
| | Application No. | Applicant(s) |
| | 09/435,736 | REISMAN, ARTHUR |
| | Examiner Minh Dieu Nguyen | Art Unit 2137 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-36 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| <ol style="list-style-type: none"> 1)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | <ol style="list-style-type: none"> 4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____. 5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6)<input type="checkbox"/> Other: _____. |
|---|---|

DETAILED ACTION

Claims 2-3, 16-17 are amended and claims 29-36 are newly added.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-36 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,671,279 by Elgamal.**

- a) **As to claim 1,** Elgamal shows a two way communications between customer and merchant.

First computing device – customer (col. 3, line 39).

Second computing device – merchant (col. 3, line 40).

The first computing device communicates encrypted data to the second computing device as the customer sends a purchase request message to the merchant in which the payment method is encrypted (col. 9, line 30-33).

The first computing device communicates non-encrypted data to the second computing device as the customer sends a purchase request message to the merchant in which the name, items to order, shipping address, etc. (col. 9, line 61-66) are not encrypted.

b) **As to claims 2-3 and 16-17**, Elgamal discloses the encrypted and non-encrypted data are transmitted in the same packet or in a different packet (col. 35, line 20-29) and further comprising:

i) providing a display (considered an inherent element in a computer system i.e. CRT, screen) to a user, the display comprising at least first and second input fields for input from the user and at least a first presentation field associated with the at least first and second input fields (col. 5, lines 33-48; col. 6, lines 25-29; col. 13, lines 6-26; col. 24, lines 45-61).

ii) receiving the message from the user, wherein the message corresponds to the display and wherein first datum refers to the first input field and the second datum to the second input field of the display (col. 13, lines 6-26; col. 24, lines 45-67 – col. 25, lines 1-4).

c) **As to claims 4-5 and 11**, Elgamal indicates the same path is used for encrypted and non-encrypted data communications between customer and merchant. Moreover the system is designed to use the interactive model of the WWW for client server transactions on the Internet (col. 3, line 26-58).

d) **As to claim 6**, Elgamal shows payment instruction (PI) is encrypted by a key (col. 20, lines 56-58).

e) **As to claim 7**, Elgamal shows merchant certificate is communicated to the customer as part of the signature (col. 19, line 35-40).

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f) **As to claims 8 and 9,** Elgamal further shows a second key is employed to decrypt the payment instruction; the first and second key comprised a matched key to communicate the encrypted data (col. 30, line 56-64).

g) **As to claims 10,** Elgamal teaches the step of communicating a procedure from the merchant to the customer to communicate the encrypted data (col. 19, line 35-39).

h) **As to claims 13 and 14,** Elgamal discloses the step for customer to communicate the encrypted and non-encrypted data with the merchant through the purchase request message in which the payment method is encrypted and item list and shipping information are non-encrypted (col. 24, line 29 to col. 25, line 4).

i) **As to claim 15,** Elgamal shows a two way communications between customer and merchant.

First computing device – merchant and acquirer (col. 3, line 40-41).

Second computing device – customer (col. 3, line 39).

Merchant communicates information – a purchase form - to customer in response to a purchase request message from customer. The information includes a procedure that causes customer to fill out the purchase form with only the payment instruction field encrypted and the rest of the form filled with non-encrypted data (col. 35, line 20-29).

The merchant receives the purchase form from the customer with encrypted payment instruction along with the non-encrypted data, the merchant then passes on the information to the acquirer to decrypt the payment instruction (col. 30, line 56-62).

- j) **As to claims 18, 19 and 24,** Elgamal indicates the same path is used for encrypted and non-encrypted data communications between customer and merchant. Moreover the system is designed to use the interactive model of the WWW for client server transactions on the Internet (col. 3, line 26-58).
- k) **As to claim 20,** Elgamal shows payment instruction (PI) is encrypted by a key (col. 20, lines 56-58).
- l) **As to claims 21 and 22,** Elgamal further shows a second key is employed to decrypt the payment instruction; the first and second key comprised a matched key to communicate the encrypted data (col. 30, line 56-64).
- m) **As to claim 23,** Elgamal indicates the step of communicating a procedure from the customer to the merchant to communicate the encrypted data (col. 19, line 50-52).
- n) **As to claims 26 and 27,** Elgamal discloses the step for customer to communicate the encrypted and non-encrypted data with the merchant

through the purchase request message in which the payment method is encrypted and item list and shipping information are non-encrypted (col. 24, line 29 to col. 25, line 4).

o) **As to claim 28**, it has the same limitations as claim 15, further the computer readable program code reads on any matter for carrying software.

p) **As to claims 29 and 33**, Elgamal discloses the method wherein the first datum is confidential information to a user [i.e. payment instruction (col. 9, lines 30-33)] and the second datum is non-confidential information to the user [i.e. name, items to order, shipping address, etc. (col. 9, lines 61-66)].

q) **As to claims 30 and 34**, Elgamal discloses the method further comprising:

i) receiving the message from a user, the message comprising a plurality of input fields (col. 13, lines 6-26; col. 24, lines 45-67 – col. 25, lines 1-4).

ii) determining each input field comprising confidential information to the user and each input field comprising non-confidential information to the user, wherein the first datum is confidential information and the second datum is non-confidential information (col. 24, lines 45-67 – col. 25, lines 1-4).

r) **As to claim 31,** Elgamal discloses the method wherein the communicating steps occur at least substantially simultaneously (col. 5, lines 33-48).

s) **As to claims 32 and 35,** Elgamal discloses the method wherein the communicating steps comprise:

i) encrypting the information in each of the input fields identified as comprising confidential information (col. 9, lines 30-33; col. 13, lines 6-27).

ii) not encrypting the information in each of the input fields identified as comprising non-confidential information (col. 9, lines 61-66, col. 24, lines 46-61).

t) **As to claim 36,** Elgamal discloses a method of communication data between a first computing device and a second computing device, the method comprising:

i) providing a display (considered an inherent element in a computer system i.e. CRT, screen) to a user, the display comprising at least first and second input fields for input from the user and at least a first presentation field associated with the at least first and second input fields (col. 5, lines 33-48; col. 6, lines 25-29; col. 13, lines 6-26; col. 24, lines 45-61).

- ii) receiving a message from the user, wherein the message comprises at least a first and second datum input by the user into the at least first and second input fields, respectively, of the display, wherein the first datum is confidential to the user and the second datum is non-confidential to the user (col. 13, lines 6-26; col. 24, lines 45-67 – col. 25, lines 1-4).
- iii) identifying that the first datum is confidential information to a user [i.e. payment instruction (col. 9, lines 30-33)] and the second datum is non-confidential information to the user [i.e. name, items to order, shipping address, etc. (col. 9, lines 61-66)].
- iv) the first computing device communicating to the second computing device the first datum with encryption [i.e. the merchant receives the purchase form from the customer with encrypted payment instruction along with the non encrypted data (col. 30, lines 56-62)].
- v) the first computing device communicating to the second computing device the second datum without encryption [i.e. the merchant communicates information – a purchase form - to customer in response to a purchase request message from customer. The information includes a procedure that causes customer to fill out the purchase form with only the payment instruction field encrypted and the rest of the form filled with non-encrypted data (col. 35, line 20-29)], wherein steps (iv) and (v) occur at least substantially simultaneously (col. 5, lines 33-48).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 12 and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Elgamal as applied to claims 10 and 15 above, and further in view of US Patent 5,729,594 to Klingman.

Elgamal does not disclose the procedure is based on substantially lowest common denominator Java.

Klingman teaches JAVA is the most platform independent language designed for the Internet applications (col. 17, line 63-67 and col. 19, line 46-54).

It would have been obvious to one skilled in the art at the time the invention was made to modify Elgamal by supporting JAVA as taught in Klingman. One of ordinary skilled in the art would have been motivated to modify Elgamal to support JAVA because it's the most platform independent language designed for the Internet applications.

Response to Arguments

5. Applicant's arguments filed November 12, 2003 have been fully considered but they are not persuasive.

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i) Applicant argues that:

"The examiner states that Elgamal teaches sending both encrypted (PI value) and unencrypted (purchase order and payment instruction messages) information from a merchant to a customer. This conclusion conflicts with the clear teachings of Elgamal (col. 4, lines 33-37; col. 4, lines 52-57)".

Examiner maintains that:

The purchase order and the payment instruction messages are sent together from the card holder to the merchant (col. 9, lines 61-63), wherein the PI value should be encrypted (col. 9, lines 30-33) and others are unencrypted [i.e. name, items, shipping address (col. 9, lines 65-67)].

Elgamal teaches the payment protocol assumes the properties of privacy (col. 4, lines 33-37) and data integrity (col. 4, lines 52-57), therefore the PI value should be encrypted.

ii) Applicant argues that:

"Elgamal does state that the PI value may be sent "in the clear" (col. 10, lines 21-23, but later states (col. 10, lines 37-40).

Contrary to the Examiner's assertions, Elgamal does not state that the purchase order and payment instruction messages are not encrypted."

Examiner maintains that:

Elgamal is consistent when saying the PI value may be sent "in the clear" (col. 10, lines 21-23) due to certain Merchant-Acquirer relationships, and later

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stating it may be necessary to send the PI without encryption when a merchant with a good history could be considered trustworthy and can obtain clear account numbers from the acquirer (col. 10, lines 37-40). The purchase order is not mentioned anywhere in Elgamal to be encrypted, so as best understood it is unencrypted information.

iii) Applicant argues that:

"Elgamal refers to different messages sent at different times. It does not refer to the encryption of only parts of the same message. In the present invention, the encrypted and unencrypted input fields are requested to be transmitted by the user simultaneously or substantially simultaneously."

Examiner maintains that:

Elgamal discloses a purchase order including PI is sent from the card holder to the merchant wherein the encrypted PI is part of the same message (Figure 2) and Elgamal teaches a system uses the advantages of an interactive environment such as World Wide Web to provide all parties with an immediate response that indicates the status of the messages communicated (col. 5, lines 33-48), therefore the information is transmitted rather simultaneously or substantially simultaneously.

iv) Applicant argues that:

"Klingman, unlike Elgamal, sends confidential information over a circuit-switched telecommunications network, such as the PSTN, and non-confidential

information over a packet-switched network, such as the Internet. Consequently, there is no need for any encryption procedures or digital signatures, although encryption may be used if so desired (col. 13, lines 45-52).

Examiner maintains that:

Klingman discloses an on-line financial transaction system that uses state of the art computer telcom to provide secure and private purchasing capability of product goods, the system which uses the 900 number system in performing financial transactions (col. 6, lines 46-53), although the encryption algorithm is not being used in Klingman, his invention facilitates secure electronic purchases of goods on-line and the protocol supports JAVA codes which Elgamal does not disclose.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

- a) Affiliate Commerce System and Method, Ross, Jr. et al., (6,629,135).
- b) Transaction Authorization System, Cook et al., (6,675,153).
- c) Handheld Remote Computer Control and Methods for Secured Interactive Real-Time Telecommunications, Walsh et al., (6,144,848).

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7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**.

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dieu Nguyen whose telephone number is 703-305-9727. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse can be reached on 703-308-4789.

The fax phone numbers for the organization where this application or proceeding is assigned are:

703-746-7238 for After-Final communications

703-872-9306 for Official communications

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703-746-5661

for Non-Official/Draft communications

Any inquiry of a general nature or relating to the status of this application
or proceeding should be directed to the receptionist whose telephone number is
703-305-3900.

mdn
Minh Dieu Nguyen
Examiner
Art Unit 2137

mdn
3/4/04

G. Morse
GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100